

## **REMARKS**

Reconsideration of the subject application in view of the present amendment is respectfully requested.

Based on the foregoing amendments and the following remarks, the application is deemed to be in condition for allowance, and action to that end is respectfully requested.

### **I. Submission of Information Disclosure**

The Examiner has requested that the Applicants submit a proper information disclosure listing the patent identified in the specification.

Applicants submit herewith a proper information disclosure including the cited reference. Accordingly, Applicants respectfully request that such prior art be made of record and be considered by the Examiner.

### **II. Objection to the Specification**

The Examiner has objected to the specification based on certain informalities. Applicants have amended the specification to overcome the objection thereto. Accordingly, Applicants respectfully request withdrawal of the objection to the specification.

### **III. Rejection of Claims Under 35 U.S.C. § 112**

The Examiner has rejected claim 7 under 35 U.S.C. § 112, second paragraph for allegedly being indefinite. Claim 7 has been amended and claim 8 has been added to overcome this rejection. Accordingly, Applicants respectfully request entry of the amendment to claim 7 and withdrawal of the rejection thereto. Applicants also respectfully request entry of new claim 8. No new matter has been added.

### **IV. Rejection Over the Prior Art**

The Examiner has rejected claims 1-7 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,522,162 (Nikolich) in view of U.S. Patent No. 4,862,043 (Zieve). Applicants respectfully disagree with this rejection.

Zieve discloses a riveting system or riveting tool that uses capacitor banks to produce a current pulse of at least one millisecond through a coil of electromagnetic actuators (col. 6, lns. 23-27). The capacitors have to be reloaded for every cycle so that among the capacitors a power supply is needed during operation of the riveting system. This power might as well be a battery pack (col. 13, lns. 16-20). A combination of the gas-powered tool of Nikolich with the riveting system of Zieve would have led someone skilled in the art

towards a portable fastening tool that is actuated by electromagnetic actuators that are pulsed by capacitors and whose power supply is a battery.

In contradistinction, in the present invention the sole power supply for the electronic system during operation of the tool is the voltage supply formed by the at least one capacitor and not a battery pack or an external power supply.

The present invention is novel and inventive over the Nikolich and Zieve. Such art does not disclose the use of at least one capacitor as a sole power supply.

It is respectfully submitted that the present invention, as defined in independent claim 1 and claims 2-8 that depend therefrom, would not be obvious over the combination of Nikolich and Zieve.

Under MPEP § 2143 *prima facie* case of obviousness requires that three basic criteria be met.

First, there must be some suggestion or motivation, either in the references or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or

references when combined) must teach or suggest all of the claim limitation.

It is respectfully submitted that the first element of *prima facie* obviousness has not been established.

“obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggesting supporting the combination. Under section 103, teachings of references can be combined only if there is some suggesting or incentive to do so.”

In re Fritch, 23 U.S.P.Q. 2d 1780, 1783 (Fed. Cir 1992) (footnote omitted) (emphasis in original). See also In re Sernaker, 217 U.S.P.Q. 1, 6 (Fed. Cir. 1983); SmithKline Diagnostics, Inc. v. Helena Laboratories Corp., 8 U.S.P.Q. 2d 1397, 1399 (Fed. Cir. 1989); In re Fine, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988).

There is no suggestion, incentive or motivation in the cited references for the combination on which the Office Action relies. A statement that it would have been obvious to one skilled in the art to make modifications to the references is not sufficient to establish a *prima facie* case of obviousness.

MPEP §2143.01 relying on Ex Parte Levengood, 28 U.S.P.Q. 2d 1300 (Bd. Pat. App. & Inter. 1993). In order to establish a *prima facie* case of obviousness, “it is necessary for the Examiner to present evidence, preferably in the form of some teaching, suggesting incentive or influence in the prior art, or in the form of generally available knowledge, that one having ordinary skill in the art would have been led to combine the relevant teachings.” Id. At 1301 (emphasis in original).

The Court of Appeals for Federal Circuit has held that a claimed invention was not obvious, where “[c]onspicuously missing from [the] record as any *evidence*, other than the PTO’s speculation (if it be called evidence) that one skilled in the art would have been motivated to make the modification of the prior art “necessary to arrived at the claimed invention. In re Jones 21 U.S.P.Q. 2d 1941 (Fed. Cir. 1992).

Ex Parte Clapp, 227 U.S.P.Q. 972, 973 (Bd. Pat. App & Inter. 1985) requires that when the references do not suggest the invention “. . . the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teaching of the references.” No such line of reasoning is seen in the Office Action.

The Court of Appeals for the Federal Court clearly stated:

It is impermissible to use the claimed invention as an instruction manual or template to piece together the teaching of the prior art so that the claimed invention is rendered obvious.

In re Fritch, 23 U.S.P.Q. 2d 1780, 23 1780, 1783 (Fed. Cir. 1992)

In the In re Fritch holding only confirmed a long established view that obviousness should not be read “into an invention on the basis of Applicant’s own statements”, that the prior art must be viewed “without reading into that art Appellant’s teachings”, and that that teachings of the prior should, “in and of themselves and without the benefits of Appellant’s disclosure (emphasis in the original text) make the invention as a whole, obviously.” *In re Spinnoble*, 160 U.S.P.Q. 237, 243 (CCPA 1969). It is respectfully submitted that the teachings of the prior art does not make the present invention obvious.

The Court of Appeals for the Federal Circuit has consistently ruled that it is not permissible to use hindsight to reject a claim.

As pointed out in Uniroyal v. Redkin-Willey, 5 U.S.P.Q. 2d 1434, 1438 (Fed. Cir. 1988):

When prior art references require selective combination by the Court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself. . . . Something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination.

There is nothing in the prior art that would suggest combining such references to achieve the claimed invention.

In view of the above, it is respectfully submitted that the combination of Nikolich and Zieve does not make the present invention, as defined in Claim 1, obvious, and the present invention is patentable over said combination.

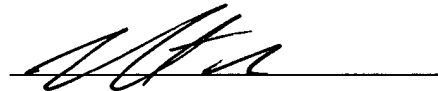
Claims 2-8 depend on Claim 1 and are allowable for the same reasons Claim 1 is allowable and further because of specific features recited therein which, when taken alone and/or in combination with features recited in Claim 1, are not disclosed or suggested in the prior art.

## CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance, and allowance of the application is respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawing be further amended or corrected in formal respects, in order to place in case in condition for final allowance, then it is respectfully requested that such amendment or correction be carried out by Examiner's amendment and the case passed issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, the Examiner is invited to telephone the undersigned.

Respectfully submitted



Ronit Gillon, Reg. No. 39,202

Dated: October 12, 2004  
Sidley Austin Brown & Wood LLP  
787 Seventh Avenue  
New York, NY 10019  
Tel.: (212) 839-7365

I hereby certify that this correspondence is being deposited with the United State Postal Service as first class mail and addressed to: Commissioner for Patents, Box 1450, Alexandria, VA 22313-1450 on October 12, 2004. \_\_\_\_\_

